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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,036

09/22/2003

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14967US02

7866

23446 7590 05/11/2011
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EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

05/11/2011

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* JEYHAN KARAOGUZ and
9 JAMES D. BENNETT
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12 Appeal 2010-004430
13 Application 10/667,036
14 Technology Center 3600
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17 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
18 ANTON W. FETTING, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL

21

STATEMENT OF THE CASE¹

Jeyhan Karaoguz and James D. Bennett (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-53, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a way of providing billing support for the exchange of media (Specification ¶ 09).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A system providing billing support for the exchange of media, the system comprising:

[1] a first television display in a first home of a first user;

[2] a first storage in the first home, the first storage

supporting media consumption by the first television display in the first home, and

having a first network protocol address;

[3] a user interface for

the selection and

display

of media content, at the first home,

the user interface allowing at least one user to create at least one user defined media channel, wherein

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 7, 2009) and Reply Brief ("Reply Br.," filed November 6, 2009), and the Examiner's Answer ("Ans.," mailed September 16, 2009).

1 the at least one user selects media content for the at
2 least one user defined media channel through the
3 user interface, and
4 the at least one user specifies, through the user
5 interface,
6 times when the user selected media content
7 will be made available on the at least one
8 user defined media channel,
9 the user interface displaying a graphical representation of
10 the at least one user defined media channel,
11 the at least one user defined media channel
12 comprising a sequence of the user selected media
13 content
14 for consumption at the times specified by
15 the at least one user,
16 wherein the at least one user defined media channel is
17 pushed
18 from the first home
19 to other authorized users
20 at locations that are separate and distinct from the
21 first home;
22 [4] at least one server storing the media content, and having a
23 second network protocol address; and
24 [5] server software that
25 receives from the first home via a communication
26 network a request for the delivery of media content,
27 the request comprising information securing
28 payment for delivery, and
29 that responds by coordinating the delivery of the media
30 content from the at least one server at the second network
31 protocol address to the first storage at the first network
32 protocol address for consumption by the first television
33 display.

The Examiner relies upon the following prior art:

Schein US 6,388,714 B1 May 14, 2002
Mark Fischetti, *The Future of TV*, 34 Technology Review 40, 2001.

Claims 1-53 stand rejected under 35 U.S.C. § 103(a) as unpatentable
over Schein and Future TV.

ISSUES

The issues of obviousness turn on whether Schein describes a user
defined media channel for those claims that require it, and whether Schein
describes a server sending data to a computer and TV.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be
supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. The media exchange network allows users to effectively
become their own broadcasters from their own homes by creating
their own media channels and pushing those media channels to
other authorized users on the media exchange network.

Specification ¶¶ 77.

02. Media channels are such that they contain music files and may
be pushed between computers over a peer-to-peer network or an
internet based network. Specification ¶¶ 84.

Facts Related to the Prior Art

Schein

03. Schein is directed to providing television schedule information on a visual interface, and for allowing the viewer to retrieve, initiate a subscription to, search, select and interact with information located in a remote database, computer network or on-line service, such as a network server on the Internet or World Wide Web. Schein 2:20-26.

04. Schein's television schedule guide is stored as files on servers which can be accessed by the World Wide Web. The television schedule guide or website may be configured for downloading the information into a computer hard drive or other suitable processor. The guide will be capable of creating personalized TV listings. Schein 14:56-64.

Future TV

05. Future TV is directed to a description of a possible future scenario of television reception. Future TV 35.

06. The technology to implement Future TV existed at the time of publication, and so was known to those of ordinary skill. Future TV 35.

ANALYSIS

Independent claims 1, 12, 23, and 29 recite systems that push a user defined media channel. We agree with the Appellants that the Examiner made no findings that such a user defined media channel was described by Schein. App. Br. 13-18. As the Appellants argue, Schein generally creates a channel selection database for controlling the selection of existing channels

1 rather than creating and pushing a new channel. Accordingly, the Examiner
2 failed to present a prima facie case as to claims 1-39.

3 Claim 40, the broadest claim, is to a system, and does not recite pushing,
4 or doing anything else with a user defined media channel. Claim 40 allows a
5 user to create such a user defined media channel and displays a graphical
6 representation of a user defined media channel. Schein allow a user to enter
7 information and displays information that would be useful in creating such a
8 user defined media channel.

9 Accordingly, claim 40 is broad enough to encompass Schein's
10 permitting and displaying the data called for in claim 40, even though Schein
11 does not explicitly create such a user defined media channel. We are
12 unpersuaded by the Appellants' argument that Future TV is a non-enabling
13 reference since Future TV explicitly states that the technology it describes
14 was already in the possession of those of ordinary skill. FF 06.

15 Claim 46 is to a system that makes no reference to a user defined media
16 channel. We are unpersuaded by the Appellants' argument that Schein fails
17 to describe the server, computer, and TV since Schein receives requests for a
18 guide at a server, from which the guide is downloaded to a local computer
19 for display on a screen or TV. FF 04. The data content securing payment
20 for delivery is given no patentable weight in a structural system claim, which
21 is defined by the structure of the system and not the contents of its data
22 input.

23 "[E]xpressions relating the apparatus to contents thereof during an
24 intended operation are of no significance in determining patentability of the
25 apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963).

CONCLUSIONS OF LAW

The rejection of claims 1-39 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is improper.

The rejection of claims 40-53 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is proper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-39 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is not sustained.
- The rejection of claims 1-53 under 35 U.S.C. § 103(a) as unpatentable over Schein and Future TV is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2010-004430
Application 10/667,036

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